

Appl. No. 09/920,481

Amdt. Dated 6/15/2005

Response to Office action dated 03/14/2005

REMARKS

Claims 1-30 and 40-41 are pending. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 1, 12, 13, 22, 40 and 41 have been amended, and claims 31-39 have been canceled, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 1, 12, 13, 22, 40 and 41 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Specification

The Examiner stated that trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. Paragraph [0019] has been amended per the Examiner's request.

Claim Objections

The Examiner objected to claim 12. The Examiner required that the term "use" in line 4 should be "user." Claim 12 has been amended per the Examiner's requirement.

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The Examiner advised that should claims 1-9 be found allowable, claims 31-39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Claims 31-39 have been canceled.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1-2, 4-6, 13-14, 16-18, 22-23, 25-27 and 40-41 under 35 USC § 103 as obvious from Gifford (USP 5,724,424) in view of Talati et al. (USP 5,903,878). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness the prior art references when combined must teach or suggest all the claim limitations. *MPEP 706.02(j)*.

Claim 1:

Claim 1 has been amended. In current form, claim 1 is patentable over Gifford in view of Talati.

Claim 2:

By virtue of its dependence from claim 1, claim 2 is patentable over Gifford in view of Talati.

Claim 2 recites, among other features, "if the second e-mail message does not have at least one order code specified by the user, then responding via e-mail to the second e-mail message with a simpler prompt message." The Examiner states that this feature is described at Gifford, FIG. 7, item 33. Gifford, FIG. 7, item 33 refers to presenting a payment form for receiving credit card information (see Gifford, FIG. 4, 5:26-28) in response to a user requesting to purchase a document (see Gifford, FIG. 3, 5:18-26). Gifford's missing payment form 33 is presented only after the user has selected a link to purchase a document. The claimed feature is directed to responding with a simpler prompt message if an order code has not been specified by the user. The cited portion of

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Gifford does not teach or suggest the claimed feature. Therefore, the rejection should be withdrawn and claim 2 should be allowed to issue.

Claims 4-6:

By virtue of their dependence from claim 1, claims 4-6 are patentable over Gifford in view of Talati.

Claims 13-14 and 16-18:

Claim 13 has been amended. In current form, claim 13 is patentable over Gifford in view of Talati. Claims 14 and 16-18 are patentable over Gifford in view of Talati based on the same rationale as set forth for claims 2 and 4-6.

Claims 22-23 and 25-27:

Claim 22 has been amended. In current form, claim 22 is patentable over Gifford in view of Talati. Claims 23 and 25-27 are patentable over Gifford in view of Talati based on the same rationale as set forth for claims 2 and 4-6.

Claims 40 and 41:

Claims 40 and 41 have been amended. In current form, claims 40 and 41 are patentable over Gifford in view of Talati.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 3, 15 and 24 under 35 USC § 103 as obvious from Gifford (USP 5,724,424) in view of Talati et al. (USP 5,903,878) further in view of Applicant Admitted Prior Art at paragraph [0004]. This rejection is respectfully traversed.

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Claim 3:

By virtue of its dependence from claim 2, claim 3 is patentable.

Claim 3 recites the feature, "receiving a third message via e-mail from the user." The Examiner stated that Gifford, FIG. 6, item 21 describes this feature. Gifford's FIG. 6 item 21 is directed to the merchant computer retrieving a digital advertisement for news articles (see Gifford, 5:49-56). Retrieving digital advertisements for news articles is not the claimed "receiving a third message via e-mail from the user." Since the cited portions of Gifford does not teach or suggest the claimed feature, the rejection should be withdrawn and claim 3 should be allowed to issue.

Claims 15 and 24:

By virtue of their respective dependence from claims 14 and 23, claims 15 and 24 are patentable.

Claims 15 and 24 are also patentable based on the same rationale as set forth for claim 3.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 7, 19 and 28 under 35 USC § 103 as obvious from Gifford (USP 5,724,424) in view of Talati et al. (USP 5,903,878) further in view of Applicant Admitted Prior Art at paragraphs [0003] – [0004]. This rejection is respectfully traversed.

Claim 7:

By virtue of its dependence from claim 1, claim 7 is patentable.

Claim 7 recites, among other features, "the items of content comprise technical support documents, the descriptions of the items of content comprise common technical support questions which are answered by the respective technical support documents." The Examiner asserted that the Applicant admits in Paragraph [0003] "the information itself may take any form including technical

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support, advertisements, data sheets, notices, etc.” The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *MPEP 706.02(j)*. The Specification at Paragraph [0003] states, “it is desirable to utilize such technologies to provide customers, potential customers, clients or other interested parties with virtually immediate access to information in a readily usable form.” The use of the term “desirable” indicates that the information was not available according to the claims. Therefore, the Applicant did not admit that the information, such as technical support, was available with virtual immediate access in a readily usable form. Because the cited portions of the Specification is not an admission of prior art, the Examiner's rationale is based on hindsight and improper. Thus, the rejection should be withdrawn and claim 7 should be allowed to issue.

Claims 19 and 28:

By virtue of their respective dependence from claims 13 and 22, claims 19 and 28 are patentable.

Claims 19 and 28 are also patentable based on the same rationale as set forth for claim 7.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 8-12, 20-21 and 29-30 under 35 USC § 103 as obvious from Gifford (USP 5,724,424) in view of Talati et al. (USP 5,903,878) further in view of Schuster et al. (USP 6,351,524). This rejection is respectfully traversed.

Claims 8-12:

By virtue of their dependence from claim 1, claims 8-12 are patentable.

Claims 20-21:

By virtue of their dependence from claim 13, claims 20-21 are patentable.

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Claims 29-30:

By virtue of their dependence from claim 22, claims 29-30 are patentable.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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